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10/541,362	04/13/2006	Alexandre Laurent	274802US0XPCT	3252
22850 7590 06/24/2010 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER PALENIK, JEFFREY T				
ART UNIT		PAPER NUMBER		
1615				
NOTIFICATION DATE		DELIVERY MODE		
06/24/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Advisory Action **Before the Filing of an Appeal Brief**

Application No. 10/541,362	Applicant(s) LAURENT ET AL.
Examiner Jeffrey T. Palenik	Art Unit 1615

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 01 June 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.
NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-17 and 20

Claim(s) withdrawn from consideration: _____

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____

13. ☐ Other: _____

/Robert A. Wax/
Supervisory Patent Examiner, Art Unit 1615

Continuation of 5. Applicant's reply has overcome the following rejection(s): Entrance on the record of Applicants' amendment is sufficient to overcome the rejection of claims 13-14 under the second paragraph of 35 USC §112.

Continuation of 11. does NOT place the application in condition for allowance because: Applicants' arguments regarding to the rejections of claims 1-17 under 35 USC 103(a) as being unpatentable over the combined teachings of Leshchiner et al., Bladel et al. and Chang et al. have been fully considered but they are not persuasive.

Applicants traverse the rejections on the grounds that the limitations of claim 1 are not met by the Leshchiner reference. It is further alleged that the combined teachings of Leshchiner and Bladel as well as Leshchiner and Chang et al., fail on similar grounds. Concerning the Leshchiner reference, Applicants assert that Leshchiner specifically states that his polymer particles are in the form of polymeric gels and this does not describe the solid particles of crosslinked polymer as found in the instant claim 1. Applicants further state that the linear polymer recited in the instant claim 1 is soluble in a physiologically acceptable medium as taught by the reference. In response, the Examiner respectfully disagrees. Applicants' remark directed to the "solid particles" is unpersuasive because Applicants have failed to show the difference between the reference and the instant invention. As set forth in the rejection and later acknowledged by Applicants, Leshchiner prepares a two-phase system which comprises a liquid phase and phase comprising swollen polymeric gel particles (pg. 3, lines 35-38). Applicants' assertion that the particles are "gel" versus "solid" is not persuasive particularly since the reference teaches that the two phases coexist as two distinct phases of matter (i.e. a particle or solid dispersed in a solution). That the particles are composed of polymeric gel is not sufficient to show that they are not "solid". Concerning the latter remark, the invention of Leshchiner again comprises a two-phase composition, the first phase of which is composed of linear polymers, some of which are recited by Applicants as species of the instantly claimed linear polymer (see instant claim 3). The second phase comprises the solution phase in which the first phase is suspended or dispersed. Furthermore, the linear polymers taught by the reference (pg. 3, lines 48-51) are taught as being made insoluble use of a cross-linking agent. Thus, in light of the teachings of the reference and further in light of MPEP 2112.01(I), Applicants have provided no evidence to show that the Leshchiner compositions are distinct from those which are instantly claimed.

Applicants' arguments with regard to the rejection of claim 20 under 35 USC 103(a) as being unpatentable over the teachings of Chang et al. have been fully considered but they are not persuasive.

Applicants argue that the linear copolymer of the instant claim 20 "does not comprise hydrolysable silyl groups [and] so Chang does not describe or suggest every feature" of the invention. In response, the Examiner respectfully disagrees for two reasons. First, Applicants' claim 20 recites the transitional phrase "comprising", which per MPEP §2111.03, is the broadest in scope concerning the inclusive components of an invention. Since Applicants' claim is completely silent to either the presence or absence of hydrolysable silyl groups, the fact that the reference even discusses them is similarly completely immaterial. The fact remains that Chang teaches the formation of a solution wherein linear copolymers, formed from copolymerizable vinyl monomers (col. 3, line 55 to col. 4, line 8) are dissolved in a solution having a hydroxyl value (e.g. water-miscible) (Abstract). Additional water miscible solvents such as ethanol are also taught.

Applicants' arguments with regard to the rejection of claim 20 under 35 USC 102(b) as being anticipated by Bajaj et al., has been fully considered, but is not persuasive.

Applicants allege that Bajaj's solvents are water or a mixture of water and acetone whereas water is excluded from claim 20. In response, the Examiner respectfully disagrees. Not only is water not excluded from the limitations of claim 20, but the claim positively recites that the composition comprises at least one biocompatible, water-miscible solvent.

Thus, for all of the foregoing reasons, each of Applicants' arguments is found unpersuasive. The above rejections are hereby maintained.